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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,408

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EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,408

Applicant(s)

NYGREN ET AL.

Examiner

Traci L. Casler

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-62 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claims are directed to a recording plan based upon the presence of a client. The claims are not clear as to whether the client is a third party, or merely an operator of calling system.

4. Additionally, claim 1 states a client monitor operable to...a monitor as disclosed is merely an apparatus used to display information the monitor does not do the execution. Is the applicant intending to claim a client processor?

5. When given the broadest reasonable interpretation the claimed invention is merely rec

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,801,618.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter is fully disclosed in the disclosure of the above noted patent. The independent instant application is narrow interpretation and an obvious variant of the claims of '618 but the variation is completely disclosed as the specifications of the patent and instant application are identical.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-62 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent Publication 20020071529 A1 Nelkenbaum. Method and System for Multimedia

Art Unit: 3629

Network Based data Acquisition, recording and distribution. Hereinafter referred to as Nelkenbaum.

10. As to claims 1, 39 and 51 Nelkenbaum teaches.

Multiple processing units(Pg. 6 ¶ 80)

Client computer generating an presences message(Pg. 7 ¶86 and 88).

Computer receiving presence message and retrieving plan template according to client identity(Pg. 7 ¶84, 88; Pg. 10 Claim 1

Developing a recording place associated with client(Pg. 7 ¶91_.

11. As to claims 2, 30, 32, 38, 40 and 52 Nelkenbaum teaches the network of voice and data(Pg. 7 ¶ 88). The examiner notes as this is claim is only requiring on of the network types all the reference only need to then further identify those limitation associated with that one network, not both. As the claims directed to the other network would not be implemented.

12. As to claims 4, 43, 45-46 and 57-58 Nelkenbaum teaches defining how many recordings to do in a timeframe.(Pg. 8 ¶ 95 Dimensions).

13. As to claims 5, 15-16 and 59 Nelkenbaum teaches expansion of recording rules(Pg. 7 ¶ 93).

14. As to claims 6, 17-18, 47-48 and 60-62 Nelkenbaum teaches defining types of recordings(Pg. 8 ¶ 95).

15. As to claims 7, 11-14, 44 and 56 Nelkenbaum teaches triggers to indicate recording.(Pg. 9 ¶ 112).

16. As to claim 8 Nelkenbaum teaches a recording plan based on the client information(Pg. 9 ¶108).
17. As to claims 9-10, 42 and 55 Nelkenbaum teaches a plan template giving priority and where the client is available(what network)(Pg. 9 ¶ 115-116).
18. As to claims 19 and 27 Nelkenbaum teaches communicating the recording plan to the recording device(Pg. 10 Claim 1 (Recording)
19. As to claims 20, 24 and 34 Nelkenbaum teaches triggers sent to the recording device to initiate recording(Pg. 8 ¶ 95).
20. As to claims 21-22, 25, 27, 30-31, 33, 35 and 49-50 Nelkenbaum teaches detecting the trigger and communicating to recording device(Pg. 9 ¶ 112).
21. As to claims 23, 26, 29 and 32 Nelkenbaum teaches the recording being authorized(Pg. 8 ¶ 97).
22. As to claim 37 Nelkenbaum teaches the network being CTI(Pg. 10 claim 8).
23. As to claims 42 and 54 Nelkenbaum teaches receiving the client information necessary to develop template(Pg. 7 ¶91).

Response to Arguments

24. Applicant's arguments with respect to claims 1-62 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC



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